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10/813,307	03/30/2004	David A. Dinsmoor	P-20772.00	3624
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MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			EXAMINER GILBERT, ANDREW M.	
			ART UNIT	PAPER NUMBER
			3767	
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			03/18/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/813,307

**Applicant(s)**

DINSMOOR ET AL.

**Examiner**

ANDREW M. GILBERT

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 17-32, 41-47, 67 and 68 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 67 and 68 is/are allowed.  
6) ☒ Claim(s) 1-3, 17-31 and 41-47 is/are rejected.  
7) ☒ Claim(s) 4-5, 20-23, 32, 41-44 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-949)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Acknowledgments*

1. This office action is in response to the reply filed on 6/8/2007.
2. In the reply, the Applicant amended claims 1 and 29 and cancelled withdrawn claims 6-16, 33-40, 48-66.
3. Claims 1-5, 17-32, 41-47, and 67-68 are pending.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 24-27, 29-31, 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Kilcoyne et al (6689056).

The applied reference has a common invention with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In reference to independent claims 1 and 29, Kilcoyne et al discloses the apparatus and method comprising: a device housing (18) sized for introduction into and residence completely within the body lumen; a fixation mechanism (Figs 8-11) to attach the device housing to a surface within the body lumen; a controlled detachment mechanism (col 9, Ins 55-col 10, ln 4) mechanically actuated to selectively self-detach the device housing from the surface of the body lumen, (Figs 8-11; col 9, Ins 25-28, 43-54; col 10, Ins 4-11; col 13, Ins 13-16; wherein the pin is disclosed and being non-dissolvable and the collet assembly is disclosed as being usable to deploy and retract pin 164 to attached and detached the device housing; and Response to Arguments).

In reference to claim 2 and 30 (see (124); Fig 16); for claim 3 and 31 (see col 10, Ins 24-26; for claim 24-25 and 45 (see col 5, ln 63-col 6, ln 4); for claim 26-27 and 46 (see col 7, ln 17-38).

6. Claims 1-3, 24-31, 45-47 rejected under 35 U.S.C. 102(e) as being anticipated by Colliou et al (7020531).

7. In reference to independent claims 1 and 29, Colliou et al discloses the apparatus and method comprising: a device housing (520) sized for introduction into and residence completely within the body lumen; a fixation mechanism (524, 564; Figs 1-13b) to attach the device housing to a surface within the body lumen; a controlled detachment mechanism (5224, 564, Figs 1-13b; col 5, Ins 36-42) mechanically actuated to selectively self-detach the device housing from the surface of the body lumen (col 4, Ins 53-56; col 5, Ins 4-21, 36-42; 48-52; col 8, Ins 9-14; Figs 10c-10e; wherein the pin is

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disclosed as being non-dissolvable and the pin anchoring device may be removed and replaced by the endoscopic connector tool; see also Response to Arguments).

8. In reference to claim 2 and 30 (see 522); for claim 3 and 31 (528; Summary); claim 24-25 and 45 (see Figs 1-13b, Summary); for claim 26-27 and 46 (see Figs 1-13b, Summary – ie col 7, lns 21-37); for claims 28 and 47 (see Figs 1-13b; Summary – ie col 7, lns 55-65).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-3, 17-19, 24-27, 29-31, 45-46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6689056. Although the conflicting claims are not identical, they are

not patentably distinct from each other because the claims in the present application are merely broader than the US Pat No 6689056. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

11. Claims 1, 17-18, 24-27, 29, 45-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-17, 62-87 of copending Application No. 10/833776. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending application. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-3, 17-18, 24-27, 29-31, 45, 46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-11, 13-16, 55-58, 61-66 of copending Application No. 10/687296. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending application. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-3, 17-19, 24-27, 29-31, 45, 46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 55-58, 66, 69, 71, 73 of copending Application No. 10/896553. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending application. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 1-3, 17-18, 24-31, 45, 46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No. 10/835425. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending application. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application. It has been held that the generic invention is anticipated by the species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

15. Applicant's arguments filed 6/8/2007 have been fully considered but they are not persuasive.

16. The Applicant argued that:

- i. Kilcoyne et al, Colliou, and US Pat No 6689056 (double patenting rejection) fail to disclose mechanical actuation of the controlled self-detachment mechanism because the detachment mechanism is done by a separate endoscope.

17. In response to the applicant's argument (i), the Examiner notes that by the deletion of the claim limitation "wherein the medical device remains completely within the body lumen until after the device is detached from the surface" in claim 1 and 29 the Applicant has significantly broadened and changed the scope of the claimed invention. By removal of that claim limitation the scope of the claimed invention can now incorporate separate endoscopes because the applicant has not clearly and structurally defined the scope of the medical device. The medical device can now include both the device housing and fixation mechanism and a separate endoscope that travels to the attachment site to self-detach the device housing via a controlled detachment mechanism. The detachment can be termed self-detachment because the endoscope can be considered to be part of the medical device. Thus, an endoscope that travels to the attachment site housing and performs mechanical activation as is performed by Kilcoyne et al, Colliou, and US Pat No 6689056 reads on the current claim limitations. The Examiner strongly suggests incorporating the deleted claim limitation and providing



further structural limitations that clearly focus on the applicant's invention having a controlled detachment mechanism that is remotely and selectively self-detachable via an external controller. The rejections are maintained.

***Allowable Subject Matter***

18. Claims 67-68 are allowed.
19. Claims 4-5, 20-23, 32, 41-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW M. GILBERT whose telephone number is (571)272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew M Gilbert/  
Examiner, Art Unit 3767  
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